

Application No. 09/909,488
Amendment and Response
January 24, 2006

Patent
Attorney Docket: 33449.8029.US00

Remarks

Applicants thank Examiner Fortuna for the courtesy extended to its representatives during the interview held on January 10, 2006.

In the present amendment, claims 1 to 30, 36 and 40 are cancelled and claims 33 and 38 are amended. As such claims 31-35 and 37-39 are pending.

Claim 38 is amended to claim "[t]he method for softening water in accordance with claim 31, wherein the output flow of permeate water has a hardness below [[3.5]] 2 grains per gallon" to further clarify the meaning of claim 38.

Though apparatus claims 1 to 30 are cancelled, Applicants do not agree with the pending rejections of said claims and reserve the right to pursue said claims at a later date.

In the office action, independent claim 31 is rejected under 35 U.S.C. § 103(a) because the Koch SR1 filter was known in the art at the time the present application was filed. However, the "new use of an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using." MPEP § 2112.02. Claim 31 claims "[a] method for softening water, the method comprising: providing a source of potable water; providing at least one nanofiltration filter element in fluid communication with the source of potable water, the nanofiltration filter element configured to reject at least 80 percent of calcium ions from potable water; receiving from the source of potable water an input flow of potable water having at least 2 grains of hardness per gallon; discharging a first output flow of permeate water comprising at least 80 percent of the input flow, and which

Application No. 09/909,488
Amendment and Response
January 24, 2006

Patent
Attorney Docket: 33449.8029.US00

has passed through the nanofiltration filter; and discharging a second output flow of non-permeate water comprising less than 20 percent of the input flow, and which has not passed through the nanofiltration filter; wherein the output flow of permeate water has a lower hardness than the output flow of non-permeate water." The prior art of record does not teach or suggest a method of softening water as claimed in claim 31.

As discussed in the interview of January 10, 2006, Applicants submit that the reference cited in the office action, titled "Koch Catalogue, Nanofiltration-Filtration Overview a KMS Leadership Category" ("Koch"), is dated "2004-2005," after the filing date of the present application, July 20, 2001, and thus is not prior art to the present application.

Further, no prior art has been cited in the present application indicating that Koch Membranes, the manufacturer of the SR1 membrane, suggested prior to the filing date of the present application, the use of said membrane for the softening of potable water under any conditions, let alone the conditions claimed in claim 31. In this regard, Applicants submit the declaration of H.S. Muralidhara ("Muralidhara declaration").

Referring to Exhibit A of the Muralidhara declaration, a document titled "Koch Membrane Systems," <<http://www.kochchemtech.com/KMS.htm>>, last viewed January 20, 2006, is provided. Exhibit A reflects a copyright of 2001, which may or may not be prior to the July 20, 2001 filing date of the present application and as such applicants make no admission as to whether or not said document is prior art to the present application. Exhibit

Application No. 09/909,488
Amendment and Response
January 24, 2006

Patent
Attorney Docket: 33449.8029.US00

A suggests several uses for Koch membranes, none of which include the softening of potable water under any conditions, let alone as claimed in independent claim 31.

Referring to Exhibit B of the Muralidhara declaration, a document titled "Membranes for Food Use" dated 1999, is provided. Exhibit B suggests the use of the SR1 membrane for dairy applications. Exhibit B does not suggest the use of the SR1 membrane for softening of potable water under any conditions, let alone under the conditions claimed in independent claim 31.

Referring to Exhibit C of the Muralidhara Declaration, a document titled "Koch Membrane Systems Introduces the SR2 Nanofiltration Membrane," which indicates a release date of July 8, 2002 – approximately one year after the filing date of the present application – is provided. Because Exhibit C is dated after the filing date of the present application, it is not prior art to the present application.

Dependent claims 32-35 and 37- 39 are patentable for the same reasons as set forth with respect to independent claim 31.

Regarding the rejection under 35 U.S.C. § 112, second paragraph of claims 2, 3, 12, 19, 20, 22, 27, and 33 "as failing to set forth the subject matter which applicant(s) regard as their invention." In view of the amendments herein, Applicants request that the rejection be withdrawn. Specifically, claims 2, 3, 12, 19, 20, 22, and 27 have been cancelled and claim 33 has been amended to read "does not."

Application No. 09/909,488
Amendment and Response
January 24, 2006

Patent
Attorney Docket: 33449.8029.US00

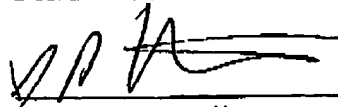
Conclusion

In view of the foregoing, it is submitted that the claims are in condition for allowance.

A Notice of Allowance is requested.

Respectfully submitted,
Perkins Coie LLP

Date: January 24, 2006



Joseph P. Hamilton
Registration No. 51,770

Correspondence Address:

Customer No. 34055
Perkins Coie LLP
Patent – LA
P.O. Box 1208
Seattle, WA 98111-1208
Phone: (310) 788-9900
Fax: (206) 332-7198